# UNITED STATES PATENT AND TRADEMARK OFFICE

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/682,312 | 10/08/2003 | Anthony G. Macaluso | 13817-005001 | 7323 |

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| EXAMINER |
|---|
| VU, MICHAEL T |

| ART UNIT | PAPER NUMBER |
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| 2683 | |

DATE MAILED: 08/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

<table>
<tr><td rowspan="2"><strong>Office Action Summary</strong></td><td><strong>Application No.</strong><br>10/682,312</td><td><strong>Applicant(s)</strong><br>MACALUSO, ANTHONY G.</td><td></td></tr>
<tr><td><strong>Examiner</strong><br>Michael Vu</td><td><strong>Art Unit</strong><br>2683</td><td></td></tr>
</table>

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**.　　2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-41* is/are pending in the application.

　　4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-41* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>07 September 2004</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

　　Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　　a)☐ All　b)☐ Some * c)☐ None of: .

　　　　1.☐ Certified copies of the priority documents have been received.

　　　　2.☐ Certified copies of the priority documents have been received in Application No. _____.

　　　　3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
　　　　　　application from the International Bureau (PCT Rule 17.2(a)).

　　* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>02/09/04</u>.

4)☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1.      The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2.      Claims 1-9, 12-20, 23-38, 40-41 are rejected under 35 U.S.C. 102(b) as being

unpatentable over Hoffman (US 6,622,017).

Regarding **claim 1**, Hoffman teaches a method for providing services to a mobile

device (Fig. 2, Wireless Carrier Network), the method comprising: receiving a request

from the mobile device for mobile service subscription options (Claim1, C16, L36-49);

sending data to the mobile device relating to mobile service subscription options

(Abstract, C16, L20-49), wherein the subscription options are sent to the mobile device

over a wireless communication path and the subscription options are for selection by a

user of the mobile device (Fig. 2, Claim 1, and C6, L35-53); receiving a selection of at

least one subscription option from the mobile device over the wireless communication

path (C16, L35-49); and activating a service corresponding to the at least one selected

subscription option in response to the selection (C16, L36-49).

Regarding **claim 2**, Hoffman teaches in claim 1, and further teaches wherein the

request for mobile subscription options from the mobile device comprises an activation

request (Hoffman teaches used more available features to request and select different

features by user, C14, L33-57).

Regarding **claim 3**, Hoffman teaches in claim 1, and further teaches wherein the

mobile device comprises a mobile phone (Fig.2, mobile phone #5).

Regarding **claim 4**, Hoffman teaches in claim 1, and further teaches wherein the

mobile device is capable of operation with a plurality of service providers (C6, L35-65).

Regarding **claim 5**, Hoffman teaches in claim 4, and further teaches wherein the

data relating to mobile subscription options comprises an identification of a plurality of

available service providers and the selection of at least one subscription option

comprises an identification of a selected service provider (C10, L5-20, and claim 5,

C17-C18 reads on).

Regarding **claim 6**, Hoffman teaches in claim 5, and further teaches wherein the

available service providers comprise mobile virtual network operators (C10, 33-43).

Regarding **claim 7**, Hoffman teaches in claim 5, and further teaches wherein

activating a service comprises sending data representing at least one setting for the

mobile device, with the data being sent over the wireless communication path (Fig. 2,

and claim 5, C17-C18).

Regarding **claim 8**, Hoffman teaches in claim 7, and further teaches wherein the

at least one setting allows the mobile device to obtain service from the selected service

provider (Fig.5, C12, L48-52, and C16, L20-48 reads on).

Regarding **claim 9**, Hoffman teaches in claim 7, and further teaches wherein the at

least one setting comprises a preferred roaming list (C1, L46-58).

Regarding **claim 12**, Hoffman teaches in claim 7, and further teaches wherein

the data relating to mobile subscription options comprises an identification of a plurality

of available service plans (C10, L5-20, and claim 5, C17-C18 reads on).

Regarding **claim 13**, Hoffman teaches in claim 1, and further teaches wherein

activating a service comprises selecting settings data associated with the selected

subscription option from stored respective sets of settings data associated with each of

the mobile services subscriptions options (C14, L43-57, and C16 claim 1 reads on).

Regarding **claim 14**, Hoffman teaches in claim 13, and further teaches wherein

the settings data comprises a preferred roaming list selected from a plurality of

preferred roaming lists (C1, L46-58).

Regarding **claim 15**, Hoffman teaches in claim 1, and further wherein the method is

performed by a server remote from and in wireless communication with the mobile

device (Fig. 2, and C3, L5-17).

Regarding **claim 16**, Hoffman teaches a method of provisioning settings for a

mobile device (C1, L46-55), the method comprising: receiving information associating a

mobile device with a particular service (C3, L50-67); identifying settings data associated

with the particular service from a database containing settings data for a plurality of

services (C10, L5-20, Fig. 2, and claim 5, C17-C18); and sending settings data for the

particular service to the mobile device over a wireless communication link (Fig.2),

wherein the settings data is configured to change operational settings for the mobile

device (Hoffman teaches a terminal user selects a desired feature or set of features and

contacts a service provider and desired to download software programming into the

mobile device, the features can be added, upgraded, or replaced at any time by

downloading, see Hoffman Summary of the Invention).

Regarding **claim 17**, Hoffman teaches in claim 16, and further teaches wherein

the particular service comprises a mobile voice communication service associated with

a specific service provider (C5, L13-31).

Regarding **claim 18**, Hoffman teaches in claim 17, and further teaches wherein

the settings data comprises a preferred roaming list for the specific service provider (C1,

46-58).

Regarding **claim 19**, Hoffman teaches in claim 17, and further teaches wherein

the settings data identifies operational settings that, when installed on the mobile

device, enable the mobile device to access the particular service provided by the

specific service provide (C10, L5-20, and claim 5, C17-C18 reads on, and C5, L13-31).

Regarding **claim 20**, Hoffman teaches in claim 17, and further teaches wherein

the particular service is offered by a mobile virtual network operator (C10, 33-43).

Regarding **claim 23**, Hoffman teaches in claim 16, and further teaches the

method of claim 16 wherein the plurality of services comprises a plurality of mutually

exclusive mobile communication services and the database of settings data stores

settings data for each of the mutually exclusive mobile communication services (claim 1,

and claim 5 reads on).

Regarding **claim 32**, Hoffman teaches a system comprising: an application

download server storing mobile device settings for accessing services associated with

at least one mobile service provider (Fig. 2, Features Services Database / OTA

Application Server, Abstract, and C2, 18-32), wherein the application download server is operable to selectively send the mobile device settings to selected mobile devices for use in modifying the settings for each selected mobile device (C2, 8-15, and C8, L41-55); and a mobile communication system interface for connecting the application download server to a mobile communication system (C1, L45-58, C1, 60-67, and C3, L35-43), wherein the mobile device settings are sent to the mobile device over a wireless communication link between the mobile device and the mobile communication system (Fig. 2 Wireless Carrier Network, and claim 1 and 5 reads on).

Regarding **claim 33**, Hoffman teaches in claim 32, and further teaches wherein the services associated with the at least one mobile service provider comprise wireless communication services (C10, L5-20, and claim 5, C17-C18 reads on).

Regarding **claim 34**, Hoffman teaches in claim 33, and further teaches wherein the mobile device settings comprise settings necessary to enable the mobile devices to access the wireless communication services for the at least one mobile service provider (C10, L5-20, and claim 5, C17-C18 reads on).

Regarding **claim 35**, Hoffman teaches in claim 33, and further teaches wherein the mobile device settings comprise a plurality of preferred roaming lists, with each preferred roaming list associated with a particular service provider (C1, L46-58).

Regarding **claim 36**, Hoffman teaches in claim 35, and further teaches wherein a preferred roaming list is sent to each mobile device, with the preferred roaming list corresponding to a selection of a service provider received through the mobile communication system interface from the mobile device (C1, L46-58).

Regarding **claim 37**, Hoffman teaches in claim 33, and further wherein the at least one mobile service provider comprises a mobile virtual network operator (C10, 33-43).

Regarding **claim 38**, Hoffman teaches in claim 33, and further wherein the application download server further stores applications for downloading to the mobile devices through the mobile communication system, with at least one of the applications comprising instructions for enabling a user to select a particular service provider from which to receive wireless communication services (C2, L33-41, claim 1 and claim 5 reads on).

Regarding **claim 40**, Hoffman teaches in claim 32, and further teaches wherein the mobile device settings comprise a software patch for one or more selected mobile devices (Abstract, Summary of the Invention, and claim 1).

Regarding **claim 41**, Hoffman teaches in claim 32, and further teaches wherein the mobile device settings comprise a telephone number (Fig. 2, and Abstract, and claim 1).

3.      Claims 24 – 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Sears (US 2002/0069263).

Regarding **claim 24**, Sears teaches a mobile device comprising: a transceiver operable to communicate over a wireless communication link (Fig. 1, User/ Device #140, teaches a system distribute information to users or mobile device); at least one memory storing an address of a server that stores settings data associated with at least

one mobile service and storing client software for an application execution environment

(mobile phone #140 received and storing application software into mobile device, claim

6 reads on), wherein the at least one memory is operable to store at least one

application that is executable on the client software and that includes instructions for

communicating with the server at the stored address (mobile phone has a transceiver,

processor, storage and memory to communicate with the server [0007, 0012]), receiving

settings data [0012], and storing the received settings data in the at least one memory

[0012]; and a processor coupled to the transceiver and the at least one memory [0012,

0014], wherein the processor is operable to execute the at least one stored application

and to control communications by the transceiver [0014, and claim 6 reads on].

Regarding **claim 25**, Sears teaches in claim 24, and further teaches wherein the

server comprises an application download server [0012, 0041].

Regarding **claim 26**, Sears teaches in claim 24, and further teaches wherein the

client software comprises Binary Runtime Environment for Wireless (BREW) client

software [0061].

Regarding **claim 27**, Sears teaches in claim 26, and further teaches wherein the

at least one application is adapted for execution by the BREW client software ([0061]

reads on).

Regarding **claim 28**, Sears teaches in claim 26, and further teaches wherein the

client software comprises Java virtual machine software (Title, Abstract, and Fig.1 Java

Apllication Servers).

Regarding **claim 29**, Sears teaches in claim 24, and further teaches wherein the

received settings data comprises settings that enable wireless communications using a

particular service provider ([0002, 0004]).

Regarding **claim 30**, Sears teaches in claim 29, and further teaches further

comprising a visual display [0005, 0009], wherein the at least one application comprises

instructions for causing the processor to [0005, 0009]: retrieve a list of available service

providers from the server [0002, 0004, and 0012]; display the list of available service

providers on the visual display [0005, 0009]; receive a user selection of a particular

service provider [0012, 0013]; and transmit an indication of the user selection from the

transceiver to the server [0012, 0013, and claim 14 reads on].

Regarding **claim 31**, Sears teaches in claim 24, and further teaches further

comprising a visual display [0005, 0009], wherein the at least one application comprises

instructions for causing the processor to [0025, 0053, 0054]: retrieve a list of available

service plans from the server [0002, 0004, 0012]; display the list of available service

plans on the visual display [0005, 0009]; receive a user selection of a particular service

plan [0012, 0013]; and transmit an indication of the user selection from the transceiver

to the server [0012, 0013, and claim 14 reads on].

## *Claim Rejections - 35 USC § 103*

4.      The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5.      This application currently names joint inventors.  In considering patentability of

the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary.  Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)

prior art under 35 U.S.C. 103(a).

6.      Claims 10,11, 21, 22, 39 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Hoffman (US 6,622,017) in view of Sears (US 2002/0069263).

        Regarding **claim 10**, Hoffman teaches in claim 7, **but is silent on** wherein the

data relating to mobile subscription options and the data representing at least one

setting for the mobile device are adapted for use on a Binary Runtime Environment for

Wireless (BREW) platform on the mobile device.  However, Sears teaches the users

can select a group consisting of download history, log of frequently used applications,

billing and subscription information, user ranking of applications, applications used in

the past, and download history ([0061, and C9 claim 14 reads on).

        Therefore, it would have been obvious to one of ordinary skill in the art at the

time the invention was made to modify Hoffman, such that the data relating to mobile

subscription options and the data representing at least one setting for the mobile device

are adapted for use on a Binary Runtime Environment for Wireless (BREW) platform on the mobile device, for consumers who have a full access to download via internet in different style in services and applications to mobile phone.

Regarding **claim 11**, Hoffman teaches in claim 7, **but is silent on** wherein the data relating to mobile subscription options and the data representing at least one setting for the mobile device are adapted for use on a Java platform on the mobile device. However, Sear teaches the wireless Java applications to optimized interaction between users, devices, and application located in a network environment (Tilte, Abstract, and [0007], and [0012]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hoffman, such that the data relating to mobile subscription options and the data representing at least one setting for the mobile device are adapted for use on a Java platform on the mobile device, to modify for consumers who have a full access to download via internet in different style in services and applications to mobile phone.

Regarding **claim 21**, Hoffman teaches in claim 16, **but is silent on** wherein the application on the mobile device is adapted for use on a Binary Runtime Environment for Wireless (BREW) platform on the mobile device. However, Sears teaches the users can select a group consisting of download history, log of frequently used applications, billing and subscription information, user ranking of applications, applications used in the past, and download history ([0061, and C9 claim 14 reads on).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hoffman, such that the application on the mobile device is adapted for use on a Binary Runtime Environment for Wireless (BREW) platform on the mobile device, for consumers who have a full access to download via internet in different style in services and applications to mobile phone.

Regarding **claim 22**, Hoffman teaches in claim 16, **but is silent on** wherein the application on the mobile device is adapted for use on a Java platform on the mobile device. However, Sear teaches the wireless Java applications to optimized interaction between users, devices, and application located in a network environment (Tilte, Abstract, and [0007], and [0012]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hoffman, such that the application on the mobile device is adapted for use on a Java platform on the mobile device, to modify for consumers who have a full access to download via internet in different style in services and applications to mobile phone.

Regarding **claim 39**, Hoffman teaches in claim 38, **but is silent on** wherein the applications are adapted for execution on a Binary Runtime Environment for Wireless (BREW) platform. However, Sears teaches the users can select a group consisting of download history, log of frequently used applications, billing and subscription information, user ranking of applications, applications used in the past, and download history ([0061, and C9 claim 14 reads on).

Therefore, it would have been obvious to one of ordinary skill in the art at the

time the invention was made to modify Hoffman, such that the application on the mobile

device is adapted for use on a Binary Runtime Environment for Wireless (BREW)

platform on the mobile device, for consumers who have a full access to download via

internet in different style in services and applications to mobile phone.


### Conclusion

7.      The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

1. Minear (US 2203/0032417)

2. Miyatsu (US 2003/0114106)

3. Wake (2004/0043753)

4. Robin (US 20040033798)

5. Majmundar (US 20040018831)

6. Nodoushani (US 6144849)

7. Austin (US 6393270)

8. Hoffman (US 6622017)

9. Sears (US 20020069263)

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Michael Vu whose telephone number is (571)272-8131.

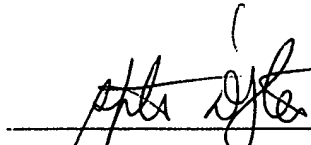The examiner can normally be reached on 8:00am - 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, William Trost can be reached on 571-272-7872. The fax phone number for

the organization where this application or proceeding is assigned is 571-272-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Michael Vu

STEPHEN D'AGOSTA
PRIMARY EXAMINER
8-2-05